



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/588,864	07/02/2007	Klaus-Wilhelm Lienert	FI-81PCT	4096
40570	7590	07/23/2009	EXAMINER	
FRIEDRICH KUEFFNER 317 MADISON AVENUE, SUITE 910 NEW YORK, NY 10017			YOON, TAE H	
			ART UNIT	PAPER NUMBER
			1796	
			MAIL DATE	DELIVERY MODE
			07/23/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/588,864	LIENERT ET AL.	
	Examiner	Art Unit	
	Tae H. Yoon	1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8/9/06, 7/2/07</u> . | 6) <input type="checkbox"/> Other: ____. |

Art Unit: 1796

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 19 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The recited “use of” is non-statutory subject matter and “method of using” is suggested instead.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 13 and 19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant failed to describe the chemical nature of the recited “Ascinin ® Anitiskin VP 242” of claim 13 and the nature of “hybrid” of claim 19 adequately.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recited "further known components known from alkyd resin chemistry" in claim 1 is indefinite absent particular component(s) since the metes and bounds of the coverage sought by applicant is unclear.

The recited "component a) contains in claim 7 is confusing and indefinite since the component a) in claim 1 is a polymer, not a combination of monomers.

The recited "technical solvent" in claim 1 and "other typical varnish solvents" in claim 11 are indefinite absent further limitation. The recited "modifier" in claims 7 and 16 and "modified" in claim 15 is indefinite absent further limitation.

Claim 13 contains the trademark/trade name Ascini[®] Anitiskin VP 242. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe antiskinning agent and, accordingly, the identification/description is indefinite. Also, the nature of said Ascini[®] Anitiskin VP 242 is indefinite.

The recited modifier in claims 15-18 improperly broadens scope of claim 1 and thus it is indefinite since no modification is recited for the component a) of claim 1.

The abbreviated "SMD" in claim 19 is indefinite and a full name is needed. Also, the nature of the "hybrid" claim 19 is indefinite.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-6, 10, 11 and 15 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP 50069193 A.

JP teaches a coating composition comprising an alkyd resin, solvents and alkyl titanate in English abstract. Said alkyd resin is the reaction product of tris(2-hydroxyethyl)isocyanate (THEIC), linseed oil fatty acid and naphthalene-2,6-dimethyldicarboxylate (NDC). Examples 3 and 4 in table 2 of JP appear to contain additional acid.

Thus, the invention lacks novelty.

Claims 1, 3-6, 8-11 and 15 are rejected under 35 U.S.C. 103(a) as obvious over JP 50069193 A.

The instant invention further recites different amounts of the reactants for the alkyd resin over JP.

However, it would have been obvious to one skilled in the art at the time of invention to modify amounts of the reactants in JP since table 2 of JP teaches utilization of different amounts and since the modification of amounts of reactants in order to obtain different molecular structure and molecular weight thereof is a considered a routine practice in the polymer chemistry absent showing otherwise.

Claims 1-7, 10, 11, 15, 16 and 19 are rejected under 35 U.S.C. 103(a) as obvious over JP 50069193 A in view of Schink et al (US 5,854,334)..

The instant invention further recites utilization of additional polyols (claim 2) and phthalic acids (claim 3, in case the examples 3 and 4 of JP show different acids) and coating of wires over JP. However, utilization of additional polyols and phthalic acids in a reaction with THEIC and NDC for obtaining an alkyd resin and coating wires thereof is well known as taught by Schink et al, col. 3 and examples. Said additional polyols and phthalic acids would meet the modifier of claims 7 and 16.

Thus, it would have been obvious to one skilled in the art at the time of invention to utilize the art well known polyols or phthalic acids of Schink et al in JP in order to obtain different molecular structure and molecular weight thereof and coating wires thereof since utilization of additional monomers in order to obtain different molecular

Art Unit: 1796

structure and molecular weight thereof is a considered a routine practice in the polymer chemistry and since JP teach a good electrical resistance which is one of the properties required by wire coating absent showing otherwise.

Claims 1, 3-6 and 10-16 are rejected under 35 U.S.C. 103(a) as obvious over JP 50069193 A in view Rao et al (US 4,983,716).

The instant invention further recites other siccative and antiskinning agents and employing additives over JP. However, utilization of the instant siccative and antiskinning agents and other additives in an alkyd coating is well known as taught by Rao et al, col. 5, line 63 to col. 6, line 57 and examples. With respect to instant claim 16, rheology modifiers at col. 5, line 67 would meet the modifier of said claim 16 absent further limitation.

Thus, it would have been obvious to one skilled in the art at the time of invention to utilize the art well known siccative and antiskinning agents and/or other additives of Rao et al in JP since utilization of such siccative and antiskinning agents and additives in an alkyd coating is a routine practice in the art absent showing otherwise.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae H. Yoon whose telephone number is (571) 272-1128. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Tae H Yoon/
Primary Examiner
Art Unit 1796

THY/July 20, 2009